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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bobbie Kaye Whitenton Baylis

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
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EXAMINER

GARCIA, ERNESTO

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/674,623	Applicant(s) BAYLIS ET AL.	
	Examiner Ernesto Garcia	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 12, 13 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 9, 10, 12, 13 and 23-30 is/are allowed.
- 6) ☒ Claim(s) 1-5, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings were received on March 6, 2006. These drawings are acceptable. However, there's a discrepancy in the figures.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first taper lock surface and the second taper lock surface define a taper lock angle that is at least twice that of the weld taper angles (claim 7, lines 3-4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. According to the drawings, in particular Figure 2A, angle A1 of the first laser weld surface, i.e., the first tapered weld surface, is approximately similar to the angle A3 of the taper lock surfaces and therefore angle A3 is not twice that of angle A1.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement

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sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Applicant remarks that it was not clear what the objection to the previous objection was. Applicant should note that the first sentence is the problem since it refers to purported merits. In other words, it is saying what laser welding is for and is not given an abstract of the invention. Further, isn't laser welding well known and shouldn't the abstract recite what is new in the art? Correction to the abstract is still required.

Claim Objections

Claim 7 is objected to because of the following informalities:

regarding claim 7, "for" in line 4 should be --of--. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the metes and bounds of the claim is unclear. In particular, it is unclear how the first component comprising an upper shell and the second component comprising a lower shell further limits the laser weld joint.

Regarding claim 3, the metes and bounds of the claim is unclear. In particular, how does the predetermined pressure further limit the laser weld joint. Is the pressure being claimed along with the weld joint?

Regarding claim 21, the metes and bounds of the claim is unclear. Since the first and second taper lock surfaces cooperate with each other and the first and second taper lock surfaces lock the first and second tapered weld surfaces as set forth in claim 1, the laser weld joint is in mating form. However, the recitation "when said first and second taper lock surfaces lock said first and second tapered weld surface together" in claim 21, lines 3-4, indicates that the surfaces are not in fact locked. Accordingly, the "when" statement in claim 21 is contrary to the condition the joint weld is in claim 1. Note that claim 1 indicates that the surfaces are locked.

Claim Rejections - 35 USC § 102

Claims 1, 2, 4, 5, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese patent, JP-2001-105500.

Regarding claim 1, the Japanese patent discloses, in Figure 6, a laser weld comprising a first component portion **11a** and a second component portion **12a**. The first component portion **11** defines a first laser weld surface **11d3** and includes a first taper lock surface **11d2** opposite from the first laser weld surface **11d3**. The second component portion **12a** defines a second laser weld surface **12d3** and includes a second taper lock surface **12d2** opposite from the second laser weld surface **12d3**. The first taper surface **11d2** and the second taper surface **12d2** cooperate with each other.

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The first laser weld surface **11d3** comprises a first tapered weld surface and the second laser weld surface **12d3** comprises a second tapered weld surface. The first and second taper surfaces lock the first and second tapered weld surfaces together and maintain a predetermined pressure.

Regarding claim 2, the first component portion **11a** comprises an upper shell and the second component portion **12a** comprises a lower shell.

Regarding claim 4, the first component portion **11a** or the second component portion **12a** is comprised of a laser-transparent material and the other of the first component portion **11a** and second component portion **12a** is comprised of an absorbing material.

Regarding claim 5, the first taper lock surface of the second taper lock surface defines a taper angle of at least 30 degrees.

Regarding claim 21, the first component portion extends to a distal tip spaced apart from the second component portion.

Claims 1, 2, 5, 21, and 22, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Behymer, 4,819,309.

Regarding claim 1, Behymer discloses, in Figures 2 and 4, a laser weld joint comprising a first component portion **12** and a second component portion **12**. The first component portion **12** defines a first laser weld surface **29** and includes a first taper lock surface **21** opposite from the first laser weld surface **29**. The second component portion **12** defines a second laser weld surface **29** and includes a second taper lock surface **30** opposite from the second laser weld surface **29**. The first laser weld surface **29** comprises a first tapered weld surface **29**. The second laser weld surface **29** comprises a second tapered weld surface **29**. The first taper weld surface **29** and the second taper weld surface **29** cooperate with each other. The first taper lock surface **21** and the second taper lock surface **30** lock the first tapered weld surface **29** and the second tapered weld surface **29** together.

Regarding claim 2, the first component portion **12** comprises an upper shell and the second component portion **12** comprises a lower shell.

Regarding claim 5, the first taper lock surface or the second taper lock surface defines a taper angle of at least thirty degrees.

Regarding claim 21, the first component portion extends to a distal tip spaced apart from the second component portion.

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Regarding claim 22, the first component portion includes a flat that transitions from the first tapered weld surface to the first tapered lock surface. The second component includes a curved surface that transitions from the second tapered weld surface **29** to the second taper lock surface **30**.

Claim Rejections - 35 USC § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent, JP-2001-105500, in view of Akiyama et al., 6,478,451.

Regarding claim 3, the Japanese patent fails to disclose a predetermined pressure is applied. Applicant is reminded that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113. Akiyama teaches, in column 3, lines 7, a predetermined pressure but does not specify the pressure being at least 190 pounds per square inch. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a pressure as part of preventing bonding failure. Applicants should note that discovering an optimum value of a result effective variable involves only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the pressure at least 190psi. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Allowable Subject Matter

Claims 9-13 and 23-30 are allowed.

Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 7, the prior art of record does not disclose or suggest a laser weld joint comprising a first taper lock surface and a second taper lock surface defining a taper lock angle that is at least twice that of weld taper angles of both a first and second tapered weld surfaces (claim 7, lines 3-4) that are different from each other (claim 7, lines 1-2). The closest prior art, Fratrack, 5,851,194, discloses different tapered angles of tapered weld surfaces; however, there is no motivation to make the taper lock angle that is at least twice that of weld tapered angles since Fratrack discloses the angles to be the same, or approximately the same;

regarding claim 8, this claim depends from claim 7;

regarding claim 9, the prior art of record does not disclose or suggest an air induction component assembly comprising a first shell made from a laser-transparent material in combination with a first laser weld surface of the first shell comprising a first tapered

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surface defining a first angle that is different from a second angle (claim 9, lines 6-8) of a second laser weld surface of a second shell made from an absorbing material). The closest prior art, Japanese patent, JP2001-105500, teaches the first angle and the second angle being similar; there is no motivation, absent applicant's own disclosure, to modify the Japanese patent because the Japanese patent is not concerned with providing pressure to the shells; and,

regarding claims 10, 12, 13, and 23-30, these claims depend from claim 9.

Response to Arguments

Applicant's arguments filed March 6, 2006 have been fully considered but they are not persuasive.

With respect to the Japanese patent '500 against claim 1, applicants argue that there is no disclosure in the Japanese patent '500 that the first and second tapered weld surfaces are locked together, that this feature cannot be ascertained from the drawing alone, and that the English abstract is insufficient to fully understand the teachings. In response, applicants should clearly note from the abstract that the invention in the Japanese patent deals with laser welding and one skilled in the art will understand from the abstract that the tapered surfaces are welded and therefore "locked together". Accordingly, the examiner does not feel that a full translation is required to understand

the merits of the Japanese patent because reading the abstract is sufficient to understand that the tapered surfaces are welded together.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the amendment to claim 1, contains the limitation of cancelled claim 6, and therefore changes the scope of the dependent claims that depend from claim 1. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EP

E.G.

June 14, 2006

Daniel P Stodola

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